

Application No. 10/807,079

Reply to Office Action

## REMARKS

*The Pending Claims*

Claims 1-50 are currently pending.

*Summary of the Office Action*

Claims 1-50 are subject to a restriction requirement under 35 U.S.C. § 121.

*Discussion of the Restriction Requirement*

The Office Action sets forth a restriction requirement between the inventions of Group I (i.e., claims 1-19 and 24-46) and Group II (i.e., claims 20-23 and 47-50). Applicant elects, with traverse, the invention of Group I (i.e., claims 1-19 and 24-46) for further prosecution.

Applicant respectfully submits that the restriction requirement is improper for the reasons set forth herein and, therefore, requests withdrawal of the restriction requirement. The M.P.E.P. recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states that there are two criteria for proper restriction between patentably distinct inventions: (a) the inventions must be independent, *and* (b) there must be a serious burden on the examiner in the absence of restriction. See M.P.E.P. § 803. These are two separate criteria that must be satisfied to support a proper restriction requirement. The fact that both criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.: "If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803 (emphasis added). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the Examiner to search and examine all of the pending claims at the same time, the Examiner is to do so, even if the pending claims are drawn to independent or distinct inventions.

With respect to the present application and the outstanding restriction requirement, Applicant submits that the inventions of Groups I and II are so related that there will be no serious burden on the Examiner to search and examine all of the subject matter defined by the pending claims at the same time. For example, Group II consists of claims 20-23 and 47-50, which are directed to a method of polishing a substrate with the polishing pads of claims 1 and 24, respectively, of Group I. If claims 1 and 24 define patentable subject matter in view

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of the prior art, then claims 20-23 and 47-50 necessarily do so as well. Thus, there is significant overlap between the methods of using the polishing pads as defined by the claims of Group II and the polishing pads as defined by the claims of Group I. Applicant notes that the Examiner did not allege, let alone demonstrate, in the Office Action that it would be a serious burden to consider all of the pending claims at the same time.

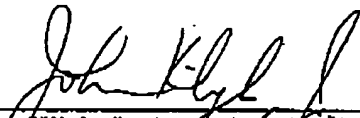
In view of the foregoing remarks, Applicant respectfully requests withdrawal of the restriction requirement, such that all of the subject matter encompassed by the pending claims is considered at the same time.

In any event, Applicant notes that, if and when a product claim of elected Group I is found allowable, the nonelected method claims of Group II that depend from or otherwise include all of the limitations of the allowable product claim should be rejoined and considered. M.P.E.P. § 821.04.

#### *Conclusion*

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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